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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/674,824	10/01/2003	Yoshihiro Nakata	P68040US1	8769

136 7590 06/27/2005

JACOBSON HOLMAN PLLC  
400 SEVENTH STREET N.W.  
SUITE 600  
WASHINGTON, DC 20004

EXAMINER

SERGEANT, RABON A

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 06/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/674,824

Applicant(s)

NAKATA ET AL.

Examiner

Rabon Sergeant

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 10/1/03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

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1. It is requested that applicants update the status of the parent application within the continuing data of the specification.
2. Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Within line 3 of claim 1, the significance and meaning of the language, "as a main component", is not clear. It is unclear what criteria must be satisfied in order for the prepolymer to be a main component.

With respect to claim 2, it is unclear if the hexamethylene diisocyanate derivative is in admixture with the prepolymer or if it is a reactant for the prepolymer.

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-5 and 7 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 6,657,035. Although the conflicting claims are not identical, they are not patentably distinct from each other because each set of claims is drawn to a moisture-curing one-pack urethane adhesive composition comprising the same components.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

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invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 11-263962.

The reference discloses moisture curable one component polyurethane adhesives comprising a urethane prepolymer, wherein hexamethylene diisocyanate is disclosed as being a suitable reactant for its production, a silane coupling agent, applicants' claimed morpholino catalysts, and a dibutyltin carboxylate catalyst that satisfies applicants' claimed tin catalyst. See pages 1-6, especially paragraphs 0027 and 0042 of the machine translation of the reference.

7. Claims 1, 2, 5, and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Araki et al. ('300).

Patentees disclose moisture curable one component polyurethane adhesives comprising a urethane prepolymer, wherein hexamethylene diisocyanate is disclosed as being a suitable reactant for its production, a silane coupling agent, applicants' claimed morpholino catalysts, and a dibutyltin dicarboxylate catalyst that satisfies applicants' claimed tin catalyst. See abstract; columns 5-8; column 13, lines 33-38; and column 14, lines 36-39. The position is taken that one would have immediately envisioned applicants' claimed isocyanate functional silane from the disclosure at column 14, lines 38 and 39.

8. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 11-263962 or Araki et al. ('300), each in view of Seiter ('722), Emmerling et al. ('623), and Samurkas et al. ('303).


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As aforementioned, the references disclose moisture curable one component polyurethane adhesives comprising a urethane prepolymer, wherein hexamethylene diisocyanate is disclosed as being a suitable reactant for its production, a silane coupling agent, applicants' claimed morpholino catalysts, and a dibutyltin dicarboxylate catalyst that satisfies applicants' claimed tin catalyst.

9. However, the references are silent regarding applicants' claimed polyisocyanate derived silane coupling agent, the use of hexamethylene diisocyanate derivatives, according to claim 3, and the non-isocyanate functional silane coupling agent of claim 5. Still, the position is taken that these components were known components for moisture curable polyurethane compositions at the time of invention. See column 2 within Seiter. See column 2 and examples within Emmerling et al. See column 6, lines 24-56, especially lines 31 and 32, within Samurkas et al. Therefore, since it has been held that it is *prima facie* obvious to utilize a known component for its known function, the position is taken that it would have been obvious to incorporate these known moisture curable adhesive components within the compositions of the primary references. *In re Linder*, 173 USPQ 356. *In re Dial et al.*, 140 USPQ 244. The position is taken that applicants' filing date is October 1, 2003 for compositions employing tin catalysts other than dibutyltin diacetylacetonate and compositions employing the claimed polyisocyanate derived silane coupling agents.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (571) 272-1079.

R. Sergent  
June 23, 2005

  
RABON SERGENT  
PRIMARY EXAMINER